

REMARKS

The Office Action has been received and carefully considered. The Office Action rejects claims 1-12 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,601,233 to Underwood (“Underwood”) in view of U.S. Patent No. 6,895,382 to Srinivasan *et al* (“Srinivasan”). Applicants respectfully traverse these rejections. Reconsideration of claims 1-12 is respectfully requested based on the following remarks.

I. The Cited References Fail To Disclose Migrating A Legacy Enterprise

Claim 1 recites “development of migration options in a legacy transaction enterprise” and “identifying potential components for the legacy enterprise.” The remaining independent claims contain similar limitations. The cited references, alone or in combination, fail to disclose these features.

The Office Action concedes that “Underwood fails to explicitly teach providing by a computer migration options and developing by a computer the migration options.” Applicants agree. The Office turns to Srinivasan as allegedly filling the hole left by Underwood. Applicants respectfully state that reliance on Srinivasan is misplaced.

Srinivasan is directed to overseas software development outsourcing. *See* Srinivasan, Abstract, column 1, lines 10-22 and claim 1. That is, Srinivasan is directed to migrating the *location* of software development. *Id.* In sharp contrast, the present claims are directed to migrating the *components* of a legacy transactional enterprise themselves. Simply stated, Srinivasan is directed to changing *where* software is developed, whereas the present claims are directed to

changing *what* components of a legacy transaction enterprise should be migrated. Accordingly, Srinivasan is completely unrelated to the present invention as claimed.

To the extent that Srinivasan considers changing components, such consideration is limited to converting from one platform to another, *without any consideration given to options for the new platform*. Thus, Srinivasan discusses “Conversion,” which is defined as “Where an existing application (or suite of applications) is to be migrated from one platform to another.” *See* Srinivasan, column 8, lines 23-25. Importantly, Srinivasan’s invention requires that a user define the exact components of the target environment. “[I]t is important to define accurately what the various components of the source and target environments will be.” Srinivasan, column 15, lines 51-52. That is, Srinivasan does not discuss or consider developing options for replacing components of a legacy transaction enterprise. Instead, Srinivasan suffers from the problem solved by the present invention as claimed. Namely, a user of Srinivasan’s invention is required to develop, for him or herself, the specifications of a new platform. In sum, Srinivasan fails to disclose or suggest a computer-implemented method for structured development of migration options, as claimed.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because neither Underwood nor Srinivasan disclose “development of migration options in a legacy transaction enterprise” or “identifying potential components for the legacy enterprise,” Applicants respectfully request that the rejections of the claims be withdrawn.

III. Underwood Fails To Disclose Developing Risk Factors For A Legacy Enterprise

Claim 1 recites “developing risk factors for the components of the legacy enterprise.” The remaining independent claims contain similar limitations. The Office relies on Underwood as allegedly disclosing these features. As explained below, such reliance is misplaced.

Underwood is directed to generating software, rather than developing migration options. *See* Underwood, Abstract (“***A method of generating software*** based on business components.”) (emphasis added). As such, Underwood is entirely unconcerned with developing migration options for a legacy enterprise, let alone developing risk factors for components of a legacy enterprise. Underwood has no need to consider risk factors for components of a legacy enterprise because Underwood develops software from scratch. Accordingly, Underwood fails to disclose or suggest “developing risk factors for the components of the legacy enterprise” as claimed.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because Underwood fails to disclose “developing risk factors for the components of the legacy enterprise,” Applicants respectfully request that the rejections of the claims be withdrawn.

III. Underwood Fails To Disclose Identifying And Developing Risk Factors For Unmet Opportunities

Claim 1 recites “identifying unmet opportunities” and “developing risk factors for the unmet opportunities.” The remaining independent claims contain similar limitations. The Office relies on Underwood as allegedly disclosing these features. As explained below, such reliance is misplaced.

Underwood fails to consider unmet opportunities at all, let alone risk factors for unmet opportunities. The Office Action fails to point to any disclosure in Underwood that meets these limitations. Applicants respectfully request, should the Office continue its rejection, that the Office point to the specific portion of Underwood that allegedly meets these limitations.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: “[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations.” Because Underwood fails to disclose “identifying unmet opportunities” and “developing risk factors for the unmet opportunities,” Applicants respectfully request that the rejections of the claims be withdrawn.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Applicant believes that no fee is required for entry of the present Reply. Nevertheless, in the event that a variant exists between the amount tendered and that determined by the U.S. Patent and Trademark Office to enter this Reply or to maintain the present application pending, please charge or credit such variance to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,
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